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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NATALIE ROSE NOEL and DANE BUTZER

Appeal 2009-002866
Application 10/090,889
Technology Center 3700

Decided: September 9, 2009

Before DONALD E. ADAMS, MELANIE L. McCOLLUM, and
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal under 35 U.S.C. § 134 involves claims 1-26, the only claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE CASE

The claims are directed to products and methods of reducing breast movement during exercise. Claims 1, 10, 19, and 21 are illustrative:

1. A restraint that reduces breast movement while a person exercises, comprising:

a strap that fits across tops of the person's breasts, under the person's arms, and around the person's back; and

an adjustable fastener that is for fastening the strap together and that is disposed to be positioned at the person's back;

wherein at least part of the strap is sufficiently elastic so as to ensure a close fit, but is also sufficiently inelastic so that the restraint avoids contributing to movement of the breasts during exercising.

10. A method that reduces breast movement while a person exercises, comprising:

fitting a strap across tops of the person's breasts, under the person's arms, and around the person's back;

fastening the strap together with an adjustable fastener; and
positioning the adjustable fastener at the person's back;

wherein at least part of the strap is sufficiently elastic so as to ensure a close fit, but is also sufficiently inelastic so that the restraint avoids contributing to movement of the breasts during exercising.

19. A restraint that reduces breast movement while a person exercises, consisting essentially of:

a single strap that fits across tops of the person's breasts, under the person's arms, and around the person's back; and

an adjustable fastener that is for fastening the strap together;

wherein at least part of the strap is sufficiently elastic so as to ensure a close fit, but is also sufficiently inelastic so that the restraint avoids contributing to movement of the breasts during exercising.

21. A method that reduces breast movement while a person exercises, consisting essentially of:

fitting a single strap across tops of the person's breasts, under the person's arms, and around the person's back; and

fastening the strap together with an adjustable fastener;

wherein at least part of the strap is sufficiently elastic so as to ensure a close fit, but is also sufficiently inelastic so that the restraint avoids contributing to movement of the breasts during exercising.

The Examiner relies on the following prior art references to show unpatentability:

Stack	US 2,723,396	Nov. 15, 1955
Hyman	US 3,968,803	Jul. 13, 1976

The rejection presented by the Examiner is as follows:

Claims 1-26 stand rejected under 35 U.S.C § 103(a) as unpatentable over the combination of Stack and Hyman.

We affirm.

ISSUE

Have Appellants established error in the Examiner's prima facie case of obviousness?

FINDINGS OF FACT

FF 1. Stack teaches a "body muscle supporter in the form of a garment for positioning around a portion of the body thereby supporting the body" (Stack, col. 1, ll. 15-17).

FF 2. For clarity we reproduce Stack's figures 1-3 below:

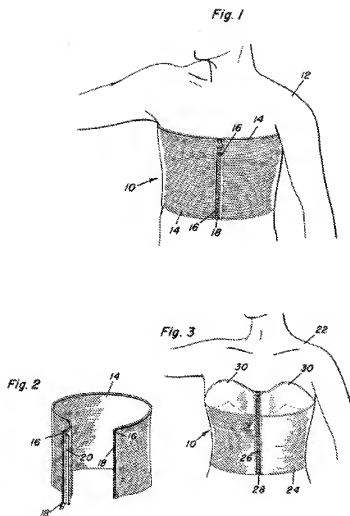


Figure 1 is a perspective view showing a view of the body muscle supporter of the present invention positioned around the body of a person;

Figure 2 is a perspective view showing the body supporter with the details of the zipper and the closure flap for protecting the body of a wearer; and

Figure 3 is a perspective view . . . showing a modified form of the body muscle support utilized by a female wearer.

(Stack, col. 1, ll. 41-49.)

FF 3. Stack teaches that the body muscle supporter 10 is positioned around a portion of the body of the wearer 12 (Stack, col. 1, ll. 50-55 and Fig. 3).

FF 4. Stack teaches that “the device may be used for support of any part of the body” (Stack, col. 2, ll. 28-29).

FF 5. With reference to Fig. 3, Stack teaches that

numeral 22 generally indicates the body of a female wearer and the elastic member 24 is provided with free end portions 26 and a closure zipper 28 similar to the device in Figure 2. The body portion 24 of the supporter 10 is provided adjacent its free ends 26 and at its upper edge with a cup member 30 which is similar to a brassiere cup utilized by women. It will be seen that a cup 30 is positioned adjacent each free end 26 of the member 24 and the zipper 28 extends to the vertical upper edge of the cups 30 thereby providing a convenient body support 10 for a female wearer 22.

(Stack, col. 2, ll. 6-17.)

FF 6. Stack teaches that “the supporter 10 may be constructed of any suitable elastic material . . . and the free ends may be connected by any suitable slidable type zipper or hook fasteners or the like” (Stack, col. 2, ll. 20-24).

FF 7. Stack teaches that “[i]n the case of female wearers, the brassiere attachment formed by the cups 30 may be constructed of any suitable material such as cotton or the like and this prevents the compression of the breasts while wearing the device” (Stack, col. 2, ll. 24-28).

FF 8. The Examiner finds that “[n]othing precludes the Stack embodiment of figure 1 as being reversed with the fastener on the rear” (Ans. 4).

FF 9. The Examiner finds that Stack’s zipper is not adjustable (Ans. 3).

FF 10. The Examiner relies on Hyman to teach “a chest restraint with an adjustable fastener, hook and loop material (30, 32)” (*id.*).

PRINCIPLES OF LAW

On appeal to this Board, Appellants must show that the Examiner has not sustained the required burden. *See Ex parte Yamaguchi*, <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd074412.pdf>, slip op. at 5 and 23 (BPAI Aug. 29, 2008) (precedential); *Ex parte Fu*, <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd080601.pdf>, slip op. at 5 and 20 (BPAI Mar. 31, 2008) (precedential).

“By using the term ‘consisting essentially of,’ the drafter signals that the invention necessarily includes the listed ingredients and is open to unlisted ingredients that do not materially affect the basic and novel properties of the invention.” *PPG Indus. v. Guardian Indus. Corp.*, 156 F.3d 1351, 1354 (Fed. Cir. 1998).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007). It is proper to “take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR*, 550 U.S. 398 at 418. *See also id.* at 421 (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”). 35 U.S.C § 103(a)

forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

KSR, 550 U.S. at 405 (quoting 35 U.S.C. § 103(a)).

ANALYSIS

Appellants provide separate arguments for the following four groups of claims: I. Claims 1-9; II. Claims 10-18 and 23-26; III. Claims 19 and 20; and IV. Claims 21 and 22. Claims 1, 10, 19, and 21 are representative. 37 C.F.R. § 41.37(c)(1)(vii). We discuss each representative claim in turn.

Claim 1:

Appellants assert that “Stack does not teach ‘a strap that fits across tops of the person’s breast’” (App. Br. 7).

Instead, Appellants contend that Stack’s figures 1 and 3 support the conclusion that Stack’s body muscle supporter is “a wrap that extends well below the bottoms of a person’s breasts” (*id.*). In this regard, Appellants contend that Stack’s teaching of a “cup member” that prevents “compression of the breasts while wearing the device . . . teach[es] directly against using an elastic strap across the tops of a person’s breasts” (App. Br. 7-8). We are not persuaded.

There is no requirement in Appellants’ claim 1 that the claimed restraint be used by a female. Accordingly, we are not persuaded by Appellants’ reference to the cup members (30) illustrated in Stack’s figure 3. Instead, as illustrated in Stack’s figure 1, the restraint is positioned across the tops of the person’s breasts, under the person’s arms, and around the person’s back (FF 2). Thus, notwithstanding Appellants’ contention to the contrary Stack meets this requirement of Appellants’ claim 1.

Appellants contend that “Stack fails to teach that ‘at least part of the strap is sufficiently elastic so as to ensure a close fit, but is also sufficiently inelastic so that the restraint avoids contributing to movement of the breasts during exercising’” (App. Br. 8). While Appellants recognize that this requirement “is a broad description of the required elasticity”; Appellants contend that “because Stack is not concerned with breast movement,” Stack does not teach the degree of elasticity required by claim 1 (*id.*). We are not persuaded.

Stack expressly states that “the device may be used for support of any part of the body” (FF 4). There is no evidence on this record establishing that Stack’s device that is designed to support a part of the body – will not be of sufficient elasticity to ensure a close fit and sufficiently inelastic to avoid contributing to movement of the breasts during exercise – when the restraint is positioned in the manner set forth in Stack’s figure 1.

Appellants contend that “Hyman does not remedy the foregoing deficiencies of Stack” (App. Br. 8). Having found no deficiencies in Appellants’ foregoing arguments we are not persuaded by Appellants’ contentions regarding Hyman.

Claim 10:

Appellants contend that since Stack and Hyman do not use the word “exercise” it would not have been obvious to a person of ordinary skill in this art to utilize the restraint taught by the combination of Stack and Hyman to reduce breast movement while a person exercises (App. Br. 12). We are not persuaded.

Stack teaches a device that provides support for the body. As the Examiner explains,

The limitation of exercise can include walking, flexing and bending as broadly claimed of which the Stack/Hyman device can be worn. . . . Nothing precludes the Stack/Hyman device from being worn during such exercise or athletic activity wherein any movement about such as walking, bending or flexing, is considered to be exercise or athletic activity as broadly claimed.

(Ans. 6.) We find no error in the Examiner's rationale.

Claim 19:

Appellants contend that since claim 19 makes use of the phrase "consisting essentially of" the single strap element of claim 19

is believed to be novel and inventive in that Applicants are unaware of anything in the prior art that shows that such a single fastened strap would even stay in place on its own, let alone function to reduce breast movement while a person exercises or performs some other activity as recited by claim 19

(App. Br. 10). We are not persuaded.

There is no evidence on this record to suggest that Stack's strap is not a "single strap." Further, while Appellants contend that "both Stack and Hyman . . . include portions that extend below tops of a person's breasts" there is no strap *width* requirement in claim 19. Therefore, it cannot be said that combination of Stack and Hyman does not teach a restraint that meets the limitations of claim 19 (*see, e.g.*, FF 2).

Further, assuming *arguendo* that claim 19 can be interpreted to read on a strap whose width is restricted to the extent only across the tops of person's breasts, there is no evidence on this record that a wider width will materially affect the basic and novel characteristics of the claimed invention to reduce breast movement while a person exercises (*Cf.* Ans. 5 (“The prese[n]t claims do not limit the strap to just the area across the tops of the wearer's breasts but claims any strap that will cover those area[s]”); Ans. 6 (“Claim 19 . . . does not limit the strap as being only across the area of the tops of the breasts”). The transition phrase “consisting essentially of” is permissive of additional elements that do not materially affect the basic and novel properties of the invention. *PPG*, 156 F.3d at 1354. Appellants have provided no evidence that the width of the strap taught by the combination of Stack and Hyman materially affects the basic and novel properties of Appellants' claimed invention.

Accordingly, we are not persuaded by Appellants' unsupported contention to the contrary (*see* App. Br. 9-11).

Claim 21:

Appellants contend that the “transitional phrase ‘consisting essentially of’ thereby limiting the scope of steps that could infringe the claim” (App. Br. 12). Appellants have not, however, explained how the phrase “consisting essentially of” would compel a conclusion that the Examiner's *prima facie* case of obviousness is in error. Accordingly, we are not persuaded by Appellants' contention.

CONCLUSION OF LAW

Appellants failed to establish error in the Examiner's prima facie case of obviousness.

The rejection of claims 1, 10, 19, and 21 under 35 U.S.C § 103(a) as unpatentable over the combination of Stack and Hyman is affirmed.

Since they are not argued separately, claims 2-9 fall together with claim 1; claims 11-18 and 23-26 fall together with claim 10; claim 20 falls together with claim 19; and claim 22 falls together with claim 21. 37 C.F.R. § 41.37(c)(1)(vii).

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

cdc

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